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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 09/410,162 | 09/30/99 | KLOSOWSKI | J DC4810 |

000137 IM62/1113
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| EXAMINER | |
|------------|--------------|
| CAMERON, E | |
| ART UNIT | PAPER NUMBER |

1762

DATE MAILED: 11/13/00

Handwritten number 7

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/410,162

Applicant(s)

Klosowski et al

Examiner

Erma Cameron

Group Art Unit
1762



☒ Responsive to communication(s) filed on Nov 3, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 51-71 is/are pending in the application

Of the above, claim(s) 52, 53, and 56-71 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 51, 54, and 55 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit:

DETAILED ACTION

Applicant's arguments filed 11/3/2000 have been fully considered but they are not persuasive.

Election/Restriction

1. Claims 52-53 and 56-71 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6, filed 11/3/2000.

Claim Rejections - 35 USC § 112

2. The rejection of Claims 51 and 54 and 55 under 35 U.S.C. 112, second paragraph, is withdrawn because of the amendment filed 11/3/2000.

Art Unit:

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 51, 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pinchuk (5736251).

'251 teaches forming a coating on an elastomeric article (i.e. organic) with a silane such as methyltriacetoxysilane (5:64) that is cured into a homopolymer or copolymer (6:6-19).

'251 fails to teach that the coating preserves the substrate, but such an effect would be inherent to the silanes used.

Regarding applicant's argument in the 11/3/2000 amendment that the silane is a coating material and not an impregnant, the art does not recognize any distinction between coating and impregnating (In re Marra 141 USPQ 221).

Art Unit:

5. Claims 51, 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leidheiser et al.

Leidheiser teaches the protection of an inorganic material such as steel panels with polymerized methyltriacetoxysilane (see entire article).

Leidheiser fails to teach that the coating preserves the substrate, but protection against corrosion is a type of preservation.

Regarding applicant's argument in the 11/3/2000 amendment that the silane is a coating material and not an impregnant, the art does not recognize any distinction between coating and impregnating (In re Marra 141 USPQ 221).

Conclusion


6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit:

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is (703) 308-2330.


ERMA CAMERON
PATENT EXAMINER
GROUP 1100

Erma Cameron

November 8, 2000